

REMARKS/ARGUMENTS

Claims 1 to 4 and 9 to 26 remain in this application. Claims 13 to 26 have been allowed. Of the remaining claims, Claims 1 to 4 and 9 to 12 have been rejected. Claim 1 is the only independent claim of the rejected claims.

Claim 1 has been amended to incorporate the subject matter of Claims 7 and 8 into this claim; and as a consequence, Claims 7 and 8 have been cancelled, along with Claims 5 and 6 which include the same limitations appearing in Claims 7 and 8. Consequently, in the ensuing discussion, the rejections of Claims 5, 6, 7 and 8 will be considered in conjunction with amended Claim 1.

Claims 1, 2 and 7 have been rejected under 35 U.S.C. §102 over the published U.S. application to Jacobs No. 2004/0035607. Claims 1 and 9 to 11 have been rejected under 35 U.S.C. §102(b) as anticipated by the U.S. patent to Williams No. 2,880,969. Claims 2 to 4 and 12 have been rejected under 35 U.S.C. §103(a) as unpatentable over Williams in view of Jacobs. Claims 7 and 8 have been rejected under 35 U.S.C. §103(a) as unpatentable over Williams in view of Bond U.S. patent No. 3,013,607. Finally, Claims 5 and 6 have been rejected under 35 U.S.C. §103(a) as unpatentable over Williams in view of Jacobs and further in view of Bond.

Applicant respectfully submits that for a claim to be rejected

1 for a lack of novelty under 35 U.S.C. §102(b or e), the reference  
2 must disclose every limitation recited in the rejected claim (or  
3 claims). As stated in MPEP §2131:

4 "A claim is anticipated only if each and every element as set  
5 forth in the claim is found, either expressly or inherently  
6 described, in a single prior art reference." *Vergegaal Bros.*  
7 *v. Union Oil Co. of California*, 814 F2nd 628, 631, 2 USPQ 2<sup>nd</sup>  
8 1051, 1053 (Fed. Cir. 1987) states: "The identical invention  
9 must be shown in as complete detail as is contained in the ...  
10 claim." *Richardson v. Suzuki Motor Co.*, 868 F2nd 1226, 1236,  
11 9 USPQ 2<sup>nd</sup> 1913, 1920 (Fed. Cir. 1989) states: "The elements  
12 must be arranged as required by the claim ... "

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14 Applicant respectfully traverses the rejection under 35 U.S.C.  
15 §102(e) of Claims 1,2 and 7 as anticipated by the Jacobs  
16 publication 2004/0035607 as being statutorily improper. Contrary  
17 to the Examiner's statement that there is a molded plastic casing  
18 about the soil sample, and that the soil sample is stabilized,  
19 applicant respectfully submits that these elements, as well as  
20 others recited in independent Claim 1, as now amended, and in  
21 dependent Claim 2, are not present in Jacobs.  
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24 The Jacobs device is a soil sample containment device; and it  
25 consists of a hollow plastic or metal tube, which serves as a rigid  
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1 liner used in conjunction with a larger soil sampling device not  
2 shown in Jacobs. Presumably, although not described, once the soil  
3 is sampled and is within the plastic or metal tube, multiple tube  
4 sections (soil sampler liner sections) are separated into  
5 individual sections. The individual sections may be capped at both  
6 ends, which then become a "soil sample containment device". The  
7 soil sample is more or less conformed to the tube; and it may or  
8 may not conform to the tube. Clearly, there are air spaces within  
9 the soil in the sample containment device. This also means that  
10 the soil in at least some of the samples, if not all of them, is  
11 not in continuous intimate contact with the tube surface.  
12 Essentially, the soil sample containment device of Jacobs is just  
13 that, a device or container intended for temporary storage of  
14 samples for future tests on those samples. The soil sample in  
15 Jacobs' system is not stabilized, and certainly is not stabilized  
16 by adhesively bonding the soil sample particles together. The soil  
17 sample of Jacobs is later withdrawn from the containment device for  
18 laboratory testing. It also should be noted that the Jacobs device  
19 consists of a tube with separate unit end caps which are held  
20 together in place by locking mechanisms. The transparent nature of  
21 some of the tubes of Jacobs allows visual inspection of the soil  
22 samples for voids before the liner sections are disassembled.  
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1 The plastic casing of Jacobs is not molded about the soil core  
2 sample. In Jacobs, the soil core sample is contained or held  
3 loosely within the plastic or metal casing. In addition, Jacobs  
4 does not stabilize the core sample, where the soil particles of the  
5 sample are adhesively bonded together. Consequently, a rejection  
6 of Claims 1 and 2 under 35 U.S.C. §102(e) over the Jacobs reference  
7 is improper and should be withdrawn.  
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9 Claims 1 and 9 to 11 have been rejected under 35 U.S.C.  
10 §102(b) as anticipated by the patent to Williams No. 2,880,969.  
11 The Examiner has stated that Williams discloses a soil core sample  
12 with a cylindrical shape with a first diameter and a first length,  
13 and that there is a plastic casing, made from catalytic plastic  
14 resin molded about the soil core sample, in physical contact with  
15 it.  
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17 The purpose of the device of Williams is to obtain soil  
18 samples containing petroleum from deep underground. Williams  
19 states: "The sealing agent acts to seal the pores of the core sample  
20 and thereby prevents fluids from escaping from the sample. The  
21 film of sealing agent additionally prevents contaminating  
22 substances from penetrating the sample." In Column 3, Line 42,  
23 Williams states: "The sealing agent may be of a character to form  
24 a film over the surface of a core sample which effectually seals  
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1 off the surface of the sample." In Column 3, Line 44, suitable  
2 sealing materials are stated as being, for example, a lubricant  
3 (presumably grease). Although the Examiner has stated that there  
4 is a plastic casing made of catalytic plastic resin in Williams,  
5 such a material does not appear in Williams. Among a list of  
6 "other suitable materials" is "thermoplastic materials"; but there  
7 is no mention of catalytic plastic resin.  
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9 The device of Williams provides for the sealing of a soil  
10 sample with a sealing film to prevent loss of the sample  
11 constituents, or contamination of the sample from environment.  
12 Something on the order of a flexible shrink wrap film, such as  
13 plastic food wrap, appears to be the type of material used by  
14 Williams. Williams is not specific about the material.  
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16 Williams does not disclose a plastic casing molded about a  
17 soil core sample, in intimate physical contact with the sample.  
18 Furthermore, Williams does not disclose a stabilized core sample,  
19 the particles of which are adhesively bonded together. Since these  
20 elements which appear in Claim 1 are not present in Williams, any  
21 rejection under 35 U.S.C. §102 of any claims including these  
22 elements is unsupported by the cited Williams patent.  
23 Consequently, the ground of rejection of Claims 1 and 9 to 11 as  
24 anticipated by Williams under 35 U.S.C. §102 should be withdrawn.  
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1           The remaining rejections of Claims 2 to 4, 12, 5,6,7 and 8 all  
2 are under various combinations on the grounds of obviousness under  
3 U.S.C. §103(a). Claims 2 to 4 and 12 were rejected under §103(a)  
4 as unpatentable over Williams in view of Jacobs. The Examiner's  
5 position is that Williams showed all of the limitations of the  
6 claimed invention with the exception of the disclosure of the  
7 plastic casing being clear. Jacobs was cited as disclosing a  
8 sample surrounded by clear plastic. Even if somehow a clear  
9 plastic casing could be provided over the sample of Williams, using  
10 the preformed plastic tubes of Jacobs, the combination of Claims 2  
11 to 4 and 12 (all dependent upon independent Claim 1) still would  
12 not result.  
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14           As mentioned above in the discussion of both Jacobs and  
15 Williams, neither of these patents show or even remotely suggest a  
16 stabilized core sample the particles of which are adhesively bonded  
17 together. Neither of these patent show or suggest a plastic casing  
18 which is molded about the core sample in intimate physical contact  
19 therewith. The tubular containers of Jacobs are not molded about  
20 a core sample. The core sample contained within these containers  
21 is removably or loosely contained therein; so that it subsequently  
22 can be removed from the tubular container for further analysis.  
23 That is not even remotely the structure of Claim 1, and therefore  
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1 dependent Claims 2 to 4 and 12 of this application. Even with the  
2 combination made by the Examiner, these claimed elements are not  
3 present.

4 Applicant submits that the modification of Williams to somehow  
5 incorporate a very different structure from Jacobs clearly is not  
6 suggested by either of these patents. Applicant respectfully  
7 submits that apart from applicant's own specification, there is no  
8 suggestion whatsoever of any manner of combining Williams and  
9 Jacobs in the manner used by the Examiner to reject Claims 2 to 4  
10 and 12 under 35 U.S.C. §103(a).

11 As specified in MPEP §2142, in order to properly combine  
12 references under 35 U.S.C. §103, "the Examiner must step backward  
13 in time into the shoes worn by the 'hypothetical person of ordinary  
14 skill in the art' when the invention was unknown and just before it  
15 was made." To do this, the Examiner must put aside knowledge of  
16 applicant's own disclosure and refrain from using hindsight to  
17 reach a legal conclusion based on facts gleaned from the prior art.

18 As further stated in MPEP §2142, in order to establish a prima  
19 facie case of obviousness under 35 U.S.C. §103, there must be some  
20 suggestion or motivation, either in the references themselves or in  
21 the knowledge generally available to one of ordinary skill in the  
22 art, to combine the teachings. In addition, the teaching or  
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1 suggestion to make the claimed combination and the reasonable  
2 expectation of success must both be found in the prior art and not  
3 be based on an applicant's own disclosure. Various cases in  
4 support of this are set forth in MPEP §2142; and for that reason,  
5 these cases will not further be cited here.  
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7 In addition to the foregoing, MPEP §2143.01 clearly sets forth  
8 that the mere fact that the references can be combined or modified  
9 does not render the resultant obvious, unless the prior art also  
10 suggests the desirability of such a combination. In the present  
11 case, applicant respectfully submits that it does not appear the  
12 references can be, or should be, or even might be combined  
13 together. Applicant submits that the requirement of MPEP §2143.01  
14 clearly is absent in the combination of Williams and Jacobs, which  
15 the Examiner has made in order to reject Claims 2 to 4 and 12.  
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17 MPEP §2143.01 further states that if the proposed modification  
18 would render the prior art invention being modified unsatisfactory  
19 for its intended purposes, then there is no suggestion or  
20 motivation to make the proposed modification. Applicant  
21 respectfully submits that in order to make the modification of  
22 Williams suggested by the Examiner to place the Williams sample in  
23 clear plastic tubes, it is necessary to so substantially modify the  
24 core sample of Williams that the resultant, whatever it would be,  
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1 would destroy the core sample of Williams. How does the Examiner  
2 propose to place the core sample of Williams in the different  
3 segmented containers of Jacobs? Williams certainly does not  
4 contemplate any type of such re-packaging or containment.  
5 Consequently, applicant respectfully submits that the rejection of  
6 Claims 2 to 4 and 12 under 35 U.S.C. §103(a) as unpatentable over  
7 Williams in view of Jacobs is improper; and this rejection should  
8 be withdrawn.  
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10 Claims 7 and 8 were rejected under 35 U.S.C. §103(a) as  
11 unpatentable over Williams in view of the U.S. patent to Bond No.  
12 3,013,607. Before entering into a discussion of this rejection (as  
13 now applied to Claim 1), a brief review of the disclosure of Bond  
14 is considered in order.  
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16 The Bond patent is not directed to soil samples or samples of  
17 mounted soil core samples. Bond is directed to an in situ  
18 selective plugging between contiguous strata in an oil field.  
19 Specifically, the plugging method which is disclosed in the Bond  
20 patent is used in conjunction with the recovery of petroleum from  
21 a partially depleted subterranean oil reservoir. Bond does not  
22 extract soil cores or soil samples. Instead, the purpose of Bond  
23 is to create an impermeable layer (impermeable to liquid movement)  
24 within soil strata "in place" in its underground location. Soils  
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1 are not stabilized in Bond. Instead, two liquids are introduced in  
2 different areas of the soils where the plug or impermeable layer is  
3 to be formed. Where the two liquids meet, a layer is formed which  
4 is impermeable to liquid movement, but is not physically  
5 stabilized. This layer is created as a result of the interaction  
6 of the two different liquids injected into the strata. In Column  
7 2, Line 63 of Bond it is stated: "In an illustrative embodiment of  
8 this invention, synthetic stratified cores were made by casting two  
9 layers of sand which differ in grain size using an adhesive to  
10 consolidate the sands."

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12 The Examiner has taken the position in rejecting Claims 7 and  
13 8 under 35 U.S.C. §103(a) as being unpatentable over Williams in  
14 view of Bond that Williams shows all the limitations of the claimed  
15 invention except that it does not disclose that the core sample is  
16 stabilized; nor does it show that it is adhesively bonded. At its  
17 best, Bond discloses a method for creating a barrier between upper  
18 and lower strata of in situ oil wells. Bond discloses the creation  
19 of a laboratory sample having such a plug or barrier in it. The  
20 bonding is created by two dissimilar liquids which form a layer  
21 impenetrable or impermeable to liquid movement within the sand (in  
22 the lab samples) or in the soil of the oil well location. If the  
23 two dissimilar liquids of Bond were somehow injected into the  
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1 device of Williams to obtain the core sample, it is not clear what  
2 the resultant would be. As noted previously, Williams does not  
3 disclose a stabilized core sample or a plastic casing molded about  
4 a core sample. Bond discloses a method for creating a plug or a  
5 barrier by the use of the interaction of two different liquids when  
6 they meet within the soil into which they are injected from  
7 different directions. How does the Examiner propose injecting the  
8 two different liquids of Bond into the core of Williams? Where is  
9 there any suggestion for the desirability of a combination of the  
10 method of Bond with the apparatus or method of Williams in either  
11 of these patents? The problems to be solved by the disclosures of  
12 each of these patents are entirely different and not related to one  
13 another.  
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16 The apparatus for obtaining cores in Williams does not require  
17 or even contemplate the selective plugging between layers of strata  
18 in situ or in the core of Williams. Applicant respectfully submits  
19 that in order to make any combination of Williams and Bond to  
20 reject Claims 7 and 8 (now Claim 1), it is necessary to so  
21 substantially modify Williams or both of these references that the  
22 resultant, whatever it would be, would totally destroy the  
23 "unaltered core" of Williams for its intended purpose. Applicant  
24 respectfully submits that to modify Williams in accordance with  
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1 whatever teachings of Bond might be used to do so, would render  
2 Williams inoperative for its intended purpose. As a result, there  
3 can be no suggestion or motivation to make the proposed  
4 modification apart from applicant's own disclosure.

5 Applicant respectfully submits that the only possible  
6 suggestion for any combination of Williams and Bond, as made by the  
7 Examiner, necessarily must come from applicant's specification.  
8 The disclosures of these patents frankly are incompatible for the  
9 combination suggested by the Examiner, without considerable  
10 hindsight teachings from applicant's own disclosure. Applicant  
11 respectfully submits that such a rejection clearly falls under the  
12 prohibition of MPEP §2103.01 that the mere fact that the references  
13 can be combined or modified does not render the resultant  
14 combination obvious, unless the prior art also suggests the  
15 desirability of the combination. The only possible suggestion for  
16 the combination of these references, used by the Examiner in  
17 rejecting Claims 7 and 8 (now Claim 1), necessarily must come from  
18 applicant's own specification. This is a hindsight determination,  
19 which clearly is set forth in MPEP §2142 as impermissible, and  
20 which must be avoided.

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24 Claims 5 and 6 have been rejected under 35 U.S.C. §103(a) as  
25 unpatentable over a combination of the three references, Williams,  
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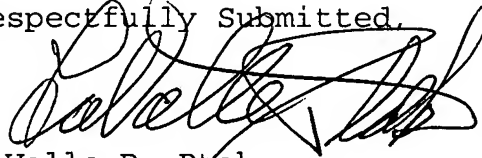
1 Jacobs and Bond. The combination of Williams and Jacobs and the  
2 shortcomings of this combination have been discussed previously.  
3 By combining Bond with these two dissimilar patents, a further  
4 unstatutory combination is being made to reject Claims 5 and 6 .  
5 Even though these claims have been cancelled, the specific  
6 recitation of these claims concerning the stabilization and  
7 adhesively bonded soil sample now is in Claim 1, as amended. The  
8 statements made above in conjunction with the 35 U.S.C. §103  
9 rejection of Claims 7 and 8 is considered to also be applicable to  
10 this rejection of Claims 5 and 6 (now being considered in  
11 conjunction with Claims 1 and 4). Applicant respectfully submits  
12 that there is no possible suggestion for the combination of these  
13 two very dissimilar references apart from applicant's own  
14 specification. As discussed in greater detail above in conjunction  
15 with the rejection of Claims 7 and 8 over Williams and Bond, the  
16 only possible suggestion for the combination being made by the  
17 Examiner in rejecting Claims 5 and 6 (considered with Claims 1 and  
18 4) necessarily must come from applicant's own specification. This  
19 also is a hindsight determination, which clearly is set forth in  
20 MPEP §2142 as impermissible, and which must be avoided. The  
21 rejection is considered improper; and applicant respectfully  
22 requests withdrawal of the rejection of any Claims 1 and 4 under 35  
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1 U.S.C. §103(a) as made by the Examiner be withdrawn.

2 In view of the foregoing, applicant requests reconsideration  
3 and withdrawal of all of the rejections of Claims 1 to 12 of this  
4 application. Applicant respectfully requests allowance of Claims  
5 1 to 4 and 9 to 12, along with previously allowed Claims 13 to 26;  
6 and a formal Notice of Allowance is respectfully solicited.  
7

8  
9 Respectfully Submitted.

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